

**REMARKS**

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and in view of the reasons which follow.

At the time of captioned Office Action, claims 71-119 were pending in the application. Claims 82, 104-106, 108-114, drawn to non-elected invention, remain withdrawn from further consideration.

Without acquiescing to the propriety of the Examiner's rejections, Applicants have amended claims 90 and 100 to set forth the subject matter of the elected invention more clearly. Support for the amendment is found in the specification at page 5, second full paragraph, line 3; page 17, Example 8 – page 21, Example 15; and original claim 29.

In addition, Applicants request, pursuant to the Official Gazette notice of March 26, 1996, which establishes guidelines for treatment of product and process claims in light of *In re Ochiai*, that claims drawn to the process of extracting the claimed herbal colourants (new claims 120-148) should be included herein for consideration on the merits. Applicants also request that, at the minimum, method of use claims of the same scope as the product claims be rejoined when the product claims are found to be allowable. In anticipation of the allowance of the product claims, Applicants have added new claims 120-148 to depend from pending claim 71.

A detailed listing of all claims that are, or were, in the application, irrespective of whether the claim(s) remain under examination in the application, are presented, with an appropriate defined status identifier. These amendments do not go beyond the original disclosure of the application.

Upon entry of these amendments, claims 71-81, 83-103, 107, 115-119 and 120-148 will be pending.

**Rejections Under 35 U.S.C. §112, 2<sup>nd</sup> Paragraph**

The Examiner considers the phrase "in the ranges of traces to ppm" in claims 90 and 100 as vague and indefinite. Applicants have established the metes and bounds of these claims by redefining the range of the essential oils and fixatives as being "1 ppm to 90 ppm."

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the rejection.

**Rejections Under 35 U.S.C. §103**

The Examiner rejects claims 71-81, 83-100, 103, 107, and 115-119 over Schultz (U.S. Patent Publication 2002/00822779), in view of Tu (English Language Abstract of CN 1113773). In addition, the Examiner rejects claims 101-102 over Schultz, in view of Tu as applied to claims 71-81, 83-100, 103, 107, and 115-119, and further in view of Benford (U.S. Patent 5,110,593). The Examiner acknowledges that Schultz's teaching composition "lacks macrotomia and preferred percent weights." The Examiner, however, relies on Tu and Benford for teaching, respectively, that (a) Arnebia or Macrotomia is a plant extract for treating acne, folliculitis, dermatitis, and wrinkles, and (b) Beeswax is a carrier for use in topical composition to treat acne.

Thus, the Examiner alleges that it would have been obvious to (1) use the Arnebia of Tu in Schultz composition that contains essential oils such as *Cymbopogon nardus*, *Ocimum basilicum* and jasmine to treat acne, and (2) use beeswax as a carrier in the combined teachings of Schultz and Tu because both of these references teach a composition to treat acne. Applicants traverse the above rejections.

A proper rejection for obviousness under §103 requires consideration of two factors:

- (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition, or device, or carry out the claimed process and (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. Both the suggestion and the reasonable expectation of success must be founded in the prior art, not in the applicant's disclosure.

*In re Vaeck*, 947 F.2d 488, 493, 20 USPQ2d 1438 (Fed. Cir. 1991) [emphasis added].

Applicants submit that the present invention is not obvious over the cited references within the meaning of section 103. The present invention discloses a composition that is not therapeutically used for treating skin diseases, such as acne, as taught by the cited references. As is clearly recited in the rejected claims, the claimed composition is a cosmetic composition. Cosmetic compositions are structurally distinct

from therapeutic compositions and include lipstick, glow glitter, eye shadow or rouge. One of the ordinary skill in the art would not be motivated to combine a therapeutic composition with a cosmetic composition to treat any dermatological ailments.

Although the claimed composition uses essential oils as one of its ingredients, it is the coloured compounds from the plants of *Boraginaceae family* that form the main components of the composition. Essential oils are added to facilitate the action of these coloured compounds. More particularly, the present invention contains herbal colours that are blended with essential oils/aroma isolates selected from the group of plant species belonging to genera *Acquillaria*, *Cinnamomum*, *Cymbopogon Elettaria*, *Eucalyptus*, *Geranium*, *Jasminum*, *Ocimum*, *Pelargonium*, *Rosa*, *Rosmarinus*, *Santalum* and *Vetiveria*. It, therefore, can provide special properties, such as mood lifting, antidepressant, anti-stress, sensual pleasure providing, creative thought inducing, anxiety reducing, refreshing, stimulant, soothing and fragrance, none of which are suggested by any combination of the cited references.

Contrary to the claimed composition, Schultz's composition contains essential oils that are useful for treating dermatological diseases and does not contain a herbal colourant, as instantly claimed. In fact, Schultz's composition falls under the drug category for the treatment of skin ailments. It is, therefore, evident that Schultz's composition was never intended for cosmetic applications, as taught by the present invention. Thus, one of ordinary skill in the art would not have been motivated to combine Schultz with any of the secondary references.

On the other hand, the claimed composition does not include an artificial ingredient. Instead, it contains a naturally occurring coloured agent along with essential oils in a cosmetic composition. As mentioned above, the combination of the herbal colours and aroma are included in the claimed cosmetic composition especially for lips, eyes and cheeks. These cosmetic agents are blended with essential oil or aroma isolates from the groups of plant species belonging to genera *Acquillaria*, *Cinnamomum*, *Cymbopogon*, *Elettaria*, *Eucalyptus*, *Citrus*, *Jasmimum*, *Ocimum*, *Pelargonium*, *Rosa*, *Rosmarinus*, *Santalum* and *Vetiveria*. It is not the essential oils that provide the herbal colours or aroma but rather, the herbal colour or aroma isolated from plant species belonging to the genera of the *Boraginaceae* family. These plant species have secondary metabolites, which are coloured compounds that are non-toxic and

produce no side effects. Further, these coloured compounds can be used as natural herbal colorants for lipsticks, eye shadows and other cosmetics. Thus, Schultz's composition provides no reasonable expectation of success of the present invention.

Tu discloses a skin protecting cream, which inhibits several skin fungi and has therapeutic effects in the treatment of acne, folliculitis and exudative dermatitis. Contrary to the claimed composition, Tu, however, fails to teach a composition that comprises a herbal colourant that is useful for cosmetic applications. Tu's composition, therefore, cannot be used in cosmetic applications like lipstick, glow glitter, eye shadow and rouge. Accordingly, one of the ordinary skill would not be prompted to combine Tu's and Schultz's compositions and be reasonably expected to successfully practice the claimed invention.

Benford discloses a therapeutic ointment for the eradication and treatment of diaper dermatitis and related skin disorders. Similar to Tu and Schultz, Benford fails to teach a cosmetic composition, as presently claimed. Contrary to the claimed composition, Benford's composition cannot be used for cosmetic applications, like lipsticks, glow glitter, eye shadow or rouge.

In summary, Schultz, Tu and Benford are not patentability-defeating references since they all fail to disclose the claimed cosmetic composition which comprises "an herbal colourant isolated from a species belonging to the genera of the family *Boraginaceae*." Accordingly, the Examiner has failed to make a case of *prima facie* obviousness. Applicants, therefore, respectfully request that the above rejection be withdrawn.

**CONCLUSION**

In view of the foregoing amendments and remarks, Applicants respectfully submit that all of the pending claims are now in condition for allowance. An early notice to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

Date September 8, 2003



FOLEY & LARDNER  
Customer Number: 22428  
  
22428  
PATENT TRADEMARK OFFICE  
Telephone: (202) 672-5300  
Facsimile: (202) 672-5399

Matthew E. Mulkeen  
Attorney for Applicants  
Registration No. 44,250

Should additional fees be necessary in connection with the filing of this paper, or if a petition for extension of time is required for timely acceptance of same, the Commissioner is hereby authorized to charge Deposit Account No. 19-0741 for any such fees, and applicant(s) hereby petition for any needed extension of time.